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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/810,883

03/16/2001

David Thomas

TNX98-08-01

2201

26839

7590

07/03/2002

TANOX, INC.  
10301 STELLA LINK  
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EXAMINER

WEHBE, ANNE MARIE SABRINA

ART UNIT

PAPER NUMBER

1632

DATE MAILED: 07/03/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/810,883

Applicant(s)

THOMAS ET AL.

Examiner

Anne Marie Beckerleg

Art Unit

1632

-- Th MAILING DATE of this communication appears on the cov r she t with th correspondence addr ss --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other:

Art Unit: 1632

### **Election/Restriction**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, 14, 18-19, and 24-28, drawn to a bispecific molecule and methods of treating allergy by administering said bispecific molecule, classified in classes 530 and 514, subclasses 350 or 387.3, and 2 respectively.
- II. Claims 10-13, 15-23, drawn to vectors encoding bispecific molecules, cells comprising said vectors, methods of producing bispecific molecules using said cells, and methods of treating disease by administering either said cells or said vectors, classified in classes 435, 424, and 514, subclasses 320.1 or 325, and 93.21, and 44 respectively.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II can be related as process of making and product made. The inventions are distinct if **either** or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) **that the product as claimed can be made by another and materially different process** (MPEP § 806.05(f)). In the instant case, the bispecific molecule of invention I does not require the vectors of invention II for its production as it can be made by fusing various hybridoma cell lines. Further, the bispecific molecules, whether protein or antibody, differ significantly in structural, physical, and biological properties from

Art Unit: 1632

nucleic acid vectors. In addition, the therapeutic administration of a protein versus a nucleic acid or cells transfected with a nucleic acid differs significantly in terms of in vivo clearance and biological activity. For instance, in addition to problems associated protein stability and susceptibility to degradation in vivo, vectors must also be able to transfect/transduce the appropriate cells in vivo, and transcribe/translate therapeutic levels of the protein under in vivo conditions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, different classification, and different search requirements, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication from the examiner should be directed to Anne Marie S. Wehbé, Ph.D., whose telephone number is (703) 306-9156. The examiner can be

Art Unit: 1632

reached Mon-Thurs and every other Friday from 9:30-7:00. If the examiner is not available, the examiner's supervisor, Deborah Reynolds, can be reached at (703) 305-4051. General inquiries should be directed to the group receptionist whose phone number is (703) 308-0196. The technology center fax number is (703) 308-4242, the examiner's direct fax number is (703) 746-7024.

Dr. A.M.S. Wehbé

A handwritten signature in black ink, appearing to read 'A.M.S. Wehbé', with a stylized flourish at the end.